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Paper No. 6

MEDTRONIC, INC.
710 MEDTRONIC PARKWAY NE
MS-LC340
MINNEAPOLIS MN 55432-5604

COPY MAILED

JUL 18 2002

OFFICE OF PETITIONS

In re Application of :
Dahl, Soukup, Perttu, Thornton, :
Belden, and Sommer : DECISION REFUSING STATUS
Application No. 10/034,905 : UNDER 37 CFR 1.47(a)
Filed: 28 December, 2001 :
Attorney Docket No. P-9334.00 :
:

This is in response to the petition filed under 37 CFR 1.47(a) on 16 April, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor.

FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR 1.136(a).

The above-identified issue application was filed on 28 December, 2001, without an executed oath or declaration. Accordingly, on 8 February, 2002, Initial Patent Examination Division mailed a Notice to File Missing Parts of Nonprovisional Application, requiring an executed oath or declaration and a surcharge for its late filing. In response, on 16 April, 2002 (certificate of mailing date 8 April, 2002), petitioners filed the present petition, accompanied by authorization to charge the petition fee, the required surcharge, and a declaration naming Roger Dahl,

Thomas M. Soukup, Joe Perttu, Arnold Thornton, Elisabeth L. Belden, and John L. Sommer as joint inventors and signed by all inventors except Perttu on behalf of themselves and on behalf of joint inventor Perttu.

Petitioners' counsel states that counsel contacted joint inventor Perttu and asked him to execute an assignment but that he has refused to execute the application papers.

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks item (1) and (2). In regards to item (1), petitioners have not shown that a copy of the application papers (specification, including claims, drawings, if any, and the declaration) were sent or given to the nonsigning inventor for review.

Petitioners may show proof that a copy of the application (specification, including claims, drawings, if any, and the declaration) was sent or given to the non-signing inventor for review¹ by providing a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first-hand knowledge of the details.

Likewise, before a *bona fide* refusal can be alleged, petitioners must show that a copy of the application as filed was sent or given to the non-signing inventor. If there is a written refusal, petitioners should supply a copy of that written refusal with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

¹See MPEP 409.03(d).

In regards to item (2), the declaration filed on 16 April, 2002 does not state that the person(s) making the oath or declaration acknowledge the duty to disclose to the Office all information known to the person(s) to be material to patentability as defined in 37 CFR 1.56. Rather, the declaration filed on 16 April, 2002, incorrectly acknowledges a duty to disclose all information material to examination of the application. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor, must be submitted with any renewed petition.

The petition fee will be charged to counsel's deposit account, No. 13-2546, as authorized by the cover letter filed with the present petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



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